



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,420	09/13/2003	Walter E. Pipo	PipoW_P_1_03	8103
34442	7590	03/02/2006	EXAMINER	
PATRICIA M. COSTANZO PATENT COPYRIGHT TRADEMARK LAW 2960 BOWEN ROAD ELMA, NY 14059			CARIASO, ALAN B	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/661,420	PIPO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alan Cariaso	2875	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Receipt of applicant's response filed 20 December 2005 is acknowledged.  
Claims 1-20 are pending, of which claims 4, 5 and 12-20 are amended.

### ***Terminal Disclaimer***

2. The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because:
3. The terminal disclaimer filed on 20 December 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond its expiration date has been reviewed and is NOT accepted.

The disclaimer fee of \$65 in accordance with 37 CFR 1.20(d) has not been submitted, nor is there any authorization in the application file to charge a specified Deposit Account or credit card.

The terminal disclaimer was not signed.

The terminal disclaimer was not presented in a form separate from the amendment.

### ***Double Patenting***

4. Given that the filed terminal disclaimer is not acceptable, the provisional obviousness-type double patenting rejection is reiterated below.
5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

Art Unit: 2875

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-7, 13-16, 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 13-16 and 18-20 of copending Application No. 10/736,468. Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 1, 19 and 20, of application 10/736,468, the claimed self-illuminating fabricated solid object assembly of 10/661,420 application (indicated in parenthesis) comprises at least one visually exposed surface (at least one visually exposed surface '420 claim 1), at least one aperture (ditto), said aperture opening on an accessible surface (at least one aperture open to an outer surface), at least one optical fiber (ditto) positioned within said solid object (embedded within said fabricated solid object), a first end of said optical fiber visually terminating at said visually exposed surface of said solid object (said first end of said fiber arranged to terminate at said at least one visually exposed surface of said fabricated solid object), a second end of said optical fiber operatively related to said aperture to receive light (said second end of said receptacle operatively coupled with said aperture, said second end of said receptacle adapted to reversibly receive said light source providing for operative contact of said light source with said second end of said fiber), whereby light emitted from an exchangeable light source

means is transmitted to said visually exposed surface of said solid object by said optical fiber (at least one reversibly powered light source with said second end of said receptacle ... whereby light is emitted from said visually exposed surface of said fabricated object); claim 2, further comprising at least one receptacle operatively relating to said at least one aperture, said receptacle receiving said second end of said optical fiber providing for said second end of said optical fiber to receive light (at least one receptacle embedded within said solid object, said receptacle having at least a first and a second end, said first end of said receptacle adapted to encompass said second end of said at least one optical fiber, said second end of said receptacle operatively coupled with said aperture; '420 claim 1); claim 3, further comprising said at least one receptacle receiving an exchangeable light source providing for transmission of light from said exchangeable light source to said first end of said optical fiber visually terminating at said at least one visually exposed surface of said solid object (at least one reversibly powered light source with said second end of said receptacle ... whereby light is emitted from said visually exposed surface of said fabricated object, '420 claim 1); claim 4 (ditto claim 2); claim 5, said any known solidification means includes any known molding means (said any known solidification means includes molding techniques, '420 claim 5); claim 6 (claim 6); claim 7 (claim 7); claims 13-16 & 18 (claims 13-16 & 18 of '420).

7. Furthermore claims 3 and 4 are also provisionally rejected as being depending on base claim(s) above, reciting setting techniques and pressing techniques regarding the solidification means. Please note that the method of forming the device is not germane to the issue of patentability of the device itself. Even though product-by-

process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, these (i.e. method) limitations have not been given patentable weight.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 8-12, 17, 18 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 13-16 and 18-20 of copending Application No. 10/736,468 in view of ROBB (5,619,182). Claims 8-12 recite plural patterns, unique colored light, patterns comprise seasonal designs, informational messages, advertising, a transparent object and light emitting diode. ROBB teaches embedded lighting systems that include plural patterns (16, 18, fig.2) that indicate specific operations, unique colored light using lighting diodes (40, 30) for indicating condition or messages and a transparent object (10) for allowing external visibility of lighted patterns of the assembly. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the claimed self-illuminating object assembly of the present application to include at least the type of plural, colored, indicating lights with lighting diodes and transparent object as taught by

ROBB in order to visually indicate plural operations being performed using different colored LEDs that respond to the functioning operation.

This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over HARRISON (US 4,754,372) in view of SHIH (US 6,234,657).

11. In regards to claim 19, HARRISON discloses a method for illuminating a fabricated solid object assembly, comprising the steps of: providing for at least one fabricated solid object (10d,11 in fig.2) to be illuminated; providing for at least one aperture (17, fig.5) in said at least one object (10d,11,16) to be illuminated; providing for at least one light source (31, fig.4); providing for at least one optical fiber (13) functionally embedded (fig.7) within said object (14,15,16), said fiber (13) having a first end (18) and a second end (36, fig.4) said first end (18) of said fiber (13) arranged to terminate at an at least one visually exposed surface (14, col.3, lines 55-68) of said object (10d,11); and reversibly inserting (col.3, lines 46-48) said at least one light source (31, 32) within said at least one aperture (17), said light source (31) providing illumination to a/said second end (36, fig.4) of said fiber (13) enabling light emitted from

said light source (31) to be guided from said light source (31) through said fiber (13), wherein light is emitted from said visually exposed surface (14) of said object assembly.

12. In regards to claim 20, HARRISON discloses the claimed invention, including at least one receiving means (32) embedded within said solid object (col.3, lines 43-50) and operatively coupled with said aperture (17), said receiving means (32) adapted for encompassing (col.3, lines 36-40) another end (36) of said at least one optical fiber (13), wherein said receiving means (32), wherein said receiving means (32) adapted to reversibly receive said light source means (31, fig.4) providing for operative contact of said light source means (31).

13. However, in claims 19 and 20, HARRISON does not disclose at least one light emitting diode light source or light emitting diode light source means.

14. SHIH teaches the use of at least one light emitting diode (50") as light source means (fig.9) received in a receiving means (40") holding ends (22b") of optical fibers (22") for the purpose of enabling light of pure color (col.4, lines 15-28) from the LED (50") to be guided to the display end (22a") onto the apertures of the display surface (1"). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the illumination display device of HARRISON to include the type of light emitting diode light source means as taught by SHIH in order to display a pure colored light pattern on the exposed surface of the display with simplified light source placement and construction, without complicated construction using movable color wheels or filters.



***Response to Arguments***

15. Applicant argues that Harrison does not teach a fabricated solid object as claimed by amended claim 19 and as defined by Applicant multiple times in the specification as filed, that Harrison does not teach a “fabricated solid object such as an object made of cement, concrete, glass, plastic, especially one where the optical fibers are embedded, that Harrison teaches a fibrous carpet where optical fibers are positioned so as to be standing up freely in the open between the fibers of the carpet, and that the optical fibers are to be hopefully supported by the fibers of the carpet if the fibers are manufactured densely enough to do so.

16. In response, applicant is suggesting that the claimed “fabricated solid object” is limited to the examples of materials disclosed which has been highlighted/underlined to include “cement, concrete, plaster, fiberglass, glass, and plastics”, “fabricated into a solid by the setting ... by pressing ... or any similar known techniques”. The specification including the paragraphs highlighted/underlined by the applicant has been reviewed and it is clear that the fabricated solid object is hardly limited by materials that would give it special or exclusive meaning, but by an open-ended plurality of examples of fabricated solids manufactured in a plurality examples of techniques. This is not the case of any special meaning for the disclosed or claimed “fabricated solid object”. Thus, the claimed “fabricated solid object” is interpreted in its “plain meaning”, meaning given to the term by those of ordinary skill in the art. Therefore, Harrison adequately discloses the claimed “fabricated solid object”, where Harrison’s fibrous carpet or

modular covering unit including the embedded optical fibers adequately meet the claimed "fabricated solid object" as claimed and interpreted in its plain meaning.

17. Applicant argues that Harrison does not teach the use of a light emitting diode light source, nor does Harrison teach that the optical fibers are arranged to terminate at a visually exposed surface of said solid object, nor does Harrison teach that the optical fibers are contained within the structure of the solid object, which limitation is contained within the limitations of claim 19.

18. In response, the amended addition providing at least one light emitting diode light source in claim 19 has been considered and rejected as being to be obvious similar to claim 20 under 35 USC 103 as set forth in this Office Action. As for the optical fibers arranged to terminate at visually exposed surface of said solid object and the optical fibers are contained within the structure of the solid object, these features are apparently disclosed by Harrison in figures 5 and 7 and as described in column 3, lines 55-68 as set forth in the last and reiterated in this Office Action.

19. Applicant argues that the rejection of claim 20 under 35 USC 103a as being unpatentable over Harrison in view of Shih is traversed in that the Examiner has failed to make a prima facie case of obviousness because neither Harrison nor Shih teach a fabricated solid object as defined by the examples of materials and techniques of fabrication in the specification.

20. With the same response regarding claim 19, the claimed "fabricated solid object" is interpreted in its plain meaning, and the specification's definitions of fabricated solid object are numerous examples of materials and manufacturing techniques which are

not considered to give the “fabricated solid object” and special definition or special meaning. Therefore, the claimed “fabricated solid object” in claim 20 is adequately disclosed by Harrison and Shih. The rejection set forth above stands.

### ***Conclusion***

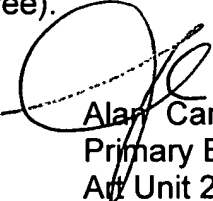
21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Cariaso whose telephone number is (571) 272-2366. The examiner can normally be reached on 9-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alan Cariaso  
Primary Examiner  
Art Unit 2875

February 27, 2006  
AC